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Supreme Court of the United States

October Term, 1952

No. 144.

CARPENTER CONTAINER CORPORATION,

Petitioner,

—vs.—

THE CONTAINER COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI INCORPORATING ARGUMENT

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CARPENTER CONTAINER CORPORATION,
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THE CONTAINER CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI INCORPORATING ARGUMENT

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

INTRODUCTORY PRAYER

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit (C.R.P.C.A.—128),* entered in the above entitled case on March 25, 1952.

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* The following abbreviations have been used in record references:
P.D.A.—designates Petitioner Defendant's Appendix
R.P.A.—designates Respondent Plaintiff's Appendix
C.R.P.C.A.—designates Certified Record of Proceedings in Court of Appeals.

OPINIONS BELOW

The judgment relates to Carpenter Patent No. 2,382,858, granted August 14, 1945, for a fibre drum or container. The opinion of the District Court* is reported at 99 F. Supp. 167 (P.D.A.—136a). It states that a new device "must reveal the flash of creative genius". The Court found that the specific claimed combination of the Carpenter patent was new and stated, "It is true that no single one of the cited prior art patents discloses the exact combination of the elements in all the details claimed in the Carpenter patent". However, the Court apparently concluded that the Supreme Court had laid down a stricter standard of invention in the cases of *Cuno Engineering Corporation* v. *Automatic Devices Corporation,* 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58 and *Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation,* 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162, and found all of the Carpenter claims in suit to be invalid in view of this stricter standard.

In reaching this conclusion the Court stated, "the combinations do not demonstrate such a degree of novelty as to constitute patentable invention over the prior art, in the light of the strict standards laid down by the Supreme Court in Cuno Engineering Corp. v. Automatic Devices Corp., supra, and more recently in Great Atlantic & Pacific Tea Co. v. Supermarket Corp., supra".

The Court of Appeals for the Third Circuit in a brief *Per Curiam* opinion reported at 194 F. 2d 1013 (C.R.P.C.A. —127) affirmed the opinion of the District Court stating, "those combinations do not demonstrate the degree of novelty necessary to constitute patentable invention over the prior art" and cited the *Cuno Engineering Corporation* v. *Automatic Devices Corporation, supra,* and *Great Atlan-*

* United States District Court for the District of Delaware in an opinion by the Honorable Richard S. Rodney dated July 12, 1951.

tic & Pacific Tea Company v. *Supermarket Equipment Corporation, supra.*

Accordingly the opinions of the courts below are concerned with the present standard of invention required to sustain the validity of a patent.

JURISDICTION

The judgment of the Court of Appeals for the Third Circuit was entered on March 25, 1952 (C.R.P.C.A.—128). The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254 (1) and 2101 (c).

QUESTIONS PRESENTED

The questions presented by this petition are:

1. Did this Honorable Court intend by its opinion in the *Cuno* and *A & P* cases, as assumed by the lower Federal Courts, to apply a higher and more rigorous standard of invention than the standard established by the U. S. Constitution as traditionally interpreted and understood?
2. If the answer to No. 1 is in the affirmative, has the judiciary not exceeded its authority in departing from such Constitutional standard?

Should the petition in this case be granted, then, it will also be necessary when the case is presented on its merits, to consider the question of whether the Carpenter patent meets the required standard of invention.

STATUTES INVOLVED

The questions presented by this petition involve an interpretation of the constitutional provision pertaining to patents, *i.e.*, Art. 1, Sec. 8, Clause 8, which reads:

> "The Congress shall have Power • • • To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

It also involves an interpretation of Revised Statute Sec. 4886 (35 U.S.C. Sec. 31) which provides:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, • • • may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefore".

STATEMENT OF THE CASE

Petitioner, Carpenter Container Corporation, is the owner of Carpenter Patent in suit No. 2,382,858 and Respondent, The Container Company, is charged with infringement of claims 7, 8 and 11 of the patent. The District Court held the three claims in issue to be invalid, "in the light of the strict standards laid down by the Supreme Court" (P.D.A.—144a). The Court of Appeals affirmed this decision in a Per Curiam opinion (C.R.P.C.A.—127).

The Container Company filed a declaratory judgment action with respect to the patent in suit. In its answer the Petitioner included a counterclaim containing two causes of action—one charging infringment of the patent in suit and the other charging violation of the anti-trust laws. The present petition is concerned only with the patent phase of the case.

The patent in suit (Respondent's Ex. 10, P.D.A.—90a) relates to fibre drums or containers. A fibre drum or container is a large container made from convolutely wound layers of kraft board or similar fibrous sheet material

adhesively laminated together to form a strong, unitary wall structure. Fibre drums and containers are used to a great extent for bulk shipments of raw materials, chemicals and munitions and the materials are stored in the containers over the period of time while they are being used or while they are being repackaged.

It is imperative that the containers be strong. It is an advantage if they can be readily opened and closed as this permits the container to be opened so that a portion of the contents can be removed, and thereafter to be closed to protect the remaining contents. It is also important that the closures form a tight seal with the containers so as to prevent contamination and leakage of the contents.

The patented invention is concerned with the construction and cooperative relationship of the upper portion of the container body, the removable head or closure and the split clamping ring for holding the closure in place. The invention produces a stronger container which is easily opened and closed and is tightly sealed. The combination set forth in each of claims 7, 8 and 11 (P.D.A.—96a and 97a) is essentially the same and consists of the following:

(1) A body member made of fibre board which is formed near one end to provide an inwardly extending rib or bead and an external groove spaced from the end.

(2) A head or closure for the said end of the body member which is provided with a portion resting on the rib or bead and another portion extending outwardly into overlapping relationship with the end of the body member, and

(3) a split clamping ring which embraces the end of the body member with its inner end portion extending into the external groove and with its outer portion overlapping the closure so as to clamp or hold the closure between the bead and the locking rim.

The patent shows several forms of construction. The claimed combination is shown in Figs. 1 and 7 (P.D.A.—90a and 91a).

The District Court, in its opinion, found that the individual elements of the combination were old. However, it found that "no single one of the cited prior art patents disclose the exact combination of the elements in all the details claimed in the Carpenter patent" (P.D.A.—143a). In other words, the double overlapping relationship of the head, clamping ring and body portion with auxiliary support from the bead and with the head held in proper relationship with respect to the bead by means of the clamping ring, is new and is not shown in the prior art patents.

The District Court expressed the opinion that in the "final analysis the question of invention and patentability must be determined by the court upon all the evidence before it and by reference to the rather strict rules which have been, in recent years, established by the Supreme Court" (P.D.A.—141a).

The District Court then concluded that the combination in question did not "demonstrate such a degree of novelty as to constitute patentable invention over the prior art in the light of the strict standards laid down by the Supreme Court * * *" (P.D.A.—144a).

The brief Per Curiam opinion of the Court of Appeals added nothing to the opinion of the District Court and it merely constitutes an affirmance of the lower court decision (C.R.P.C.A.—127).

Accordingly, the opinions of the courts below appear to be predicated upon the belief that the Supreme Court has in recent years laid down a higher or stricter standard of invention and upon the assumption that the courts have the power to thus modify the Patent Law and require a higher standard of invention.

SPECIFICATION OF ERRORS

The courts below erred:

1. In concluding that the Supreme Court has laid down a stricter standard of invention in the cases of *Cuno Engineering Corporation* v. *Automatic Devices Corporation*, 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58, and *Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation*, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162.

2. In failing to conclude that the courts do not have the power to modify the Patent Law by laying down a stricter standard of invention, and

3. In finding that the claims of the Carpenter patent in suit do not embody patentable invention in the light of the present standard of invention.

REASONS FOR GRANTING THE WRIT AND ARGUMENT

A writ of certiorari should be granted in this case because—(1) the questions raised in this petition have not been decided by the Supreme Court, and (2) the questions are of great public importance.

The Questions Raised in This Petition Have Not Been Decided by the Supreme Court

One of the defenses normally raised in patent litigation is that the patent in suit is lacking in invention and accordingly is invalid. This issue is present in most actions for patent infringement and for declaratory judgments with respect to patents.

A review of the decisions of the United States Courts of Appeals in patent cases reveals a rather widespread belief among the Courts of Appeals that the Supreme Court in recent years has laid down a stricter or higher standard

of invention. Inherent in this belief is the assumption that the judiciary has the power to lay down a stricter or higher standard of invention and to this extent modify the patent law. Thus, in the case of *Picard* v. *United Aircraft Corporation,* 128 F. 2d 632 the Court of Appeals for the Second Circuit stated—

> "We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent" (p. 636).

In the case of *United States Gypsum Co.* v. *Consolidated Expanded Metal Companies,* 130 F. 2d 888, the Court of Appeals for the Sixth Circuit stated—

> "Much water has flowed over the patent dam and we must recognize as have other courts and our own * * *. 'the high standard demanded for invention by the decisions of the Supreme Court in recent years'" (p. 892).

In the case of *Alemite Co.* v. *Jiffy Lubricator Co.,* 176 F. 2d 444, the Court of Appeals for the Eighth Circuit stated—

> "Implications favorable to the plaintiff which might, perhaps, be drawn from some of the statements of this Court in Stewart-Warner Corporation v. Jiffy Lubricator Co., supra, 81 F. 2d 786, must be considered in the light of the more recent decisions of the Supreme Court raising the standards of originality necessary to sustain a patent. That such standards have been raised has been expressly recognized by the Circuit Court of Appeals of the Second Circuit in Picard v. United Aircraft Corporation, 128 F. 2d 632, 636, certiorari denied 317 U. S. 651, 63 S. Ct. 46, 87 L. Ed. 524, and by this

Court in Frank Adam Electric Co. v. Colt's Patent Fire Arms Mfg. Co., 8 Cir., 148 F. 2d 497, 502-503, and Koochook Co., Inc. v. Barrett, 8 Cir., 158 F. 2d 463, 466-467. What was said in those cases need not be repeated. The present attitude of the Supreme Court toward claimed patentable improvements may be gathered from Cuno Engineering Corp. v. Automatic Devices Corp., supra, 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58, and the more recent cases of Jungersen v. Ostby & Barton Co., 335 U. S. 560, 69 S. Ct. 269, and Mandel Brothers, Inc. v. Wallace, 335 U. S. 291, 69 S. Ct. 73'' (pp. 448, 449).

Similar viewpoints were also expressed in the following cases—*Gomez, et al.* v. *Granat Bros., et al.*, 177 F. 2d 266, 268 (CCA 9th); *Vapor Blast Mfg. Co., et al.* v. *Pangborn Corporation*, 186 F. 2d 230, 236 (CCA 4th); *United Specialties Co., et al.* v. *Industrial Wire Cloth Products Corp.*, 186 F. 2d 426, 428 (CCA 6th); *Paramount Industries, Inc.* v. *Solar Products Corp., et al.*, 186 F. 2d 999, 1000 (CCA 2nd); and *Lenox* v. *Landers*, 188 F. 2d 744, 745 (CCA 2nd).

As already pointed out, the opinions of the courts below in this case show that the District Court for the District of Delaware, and the Court of Appeals for the Third Circuit likewise believe that the Supreme Court has laid down a stricter or higher standard of invention.

It is quite clear from the foregoing that there is a widespread belief among the United States Courts of Appeals that the Supreme Court has laid down a stricter or higher standard of invention.

While the Courts of Appeals have expressed the belief that the standard of invention has been raised by the Supreme Court and have assumed that the judiciary have the power to thus modify the Patent Law, the Supreme Court itself has remained silent on these questions.

The Supreme Court has had occasion to pass on the question of invention on several occasions during the past decade notably in *Cuno Engineering Corporation* v. *Automatic Devices Corporation,* 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58; *Jungersen* v. *Ostby & Barton Co.,* 335 U. S. 560, 69 S. Ct. 269; and *Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation,* 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162. In each of these cases the court held the patents in suit to be invalid as lacking in invention. In none of these cases did the court specifically state that the standard of invention had been increased over the traditional requirement of invention, nor, on the other hand, did the court specifically state that the standard of invention remained the same.

In several of the cases the court made statements from which the lower courts have apparently drawn the inference that a higher standard of invention is required. Thus, in the case of *Cuno Engineering Corporation* v. *Automatic Devices Corporation,* 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58, the court stated—

> "That is to say a new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling."

This statement has been widely quoted to indicate that a different or higher standard of invention is now required. Similarly, in the concurring opinion in the case of *Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation,* 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162, we find the following statement—

> "And so it (the Patent Office) has placed a host of gadgets under the armour of patents—gadgets that obviously have had no place in the constitutional scheme of advancing scientific knowledge."

This statement has been seized upon as meaning that gadgets are no longer patentable, and that inventions which

merely advance the useful arts, as distinguished from pure science, can no longer be protected under our Patent Laws.

It is important that the uncertainty arising from these decisions be clarified and that the Supreme Court specifically pass upon the questions of whether the standard of invention has been raised and whether the judiciary has the power to thus modify the Patent Laws by requiring a stricter standard of invention.

The Questions Presented by This Petition Are of Great Public Importance

Over one-half million United States patents are now in force.* They are widely held by many individuals, corporations and partnerships. These patents pertain to, and have promoted the progress of almost every branch of the useful arts, and are important to our industrial and economic welfare. They are important to the patent owners because they represent valuable property rights. They are important to the public because they represent a full disclosure of advances and progress made in the useful arts over processes, techniques and products heretofore available.

It is important to both the patent owners and the public that the questions presented by this petition be settled as soon as possible by the Supreme Court.

If the Supreme Court has, as a matter of fact, raised the standard of invention so that under the new standard many of the patents now in force are no longer valid, then valuable property rights of the patent owners have been destroyed by judicial action. Inventors should be apprized as to the present status of the law on the question of invention so that they can decide whether the Patent Laws afford

* Patent No. 2,006,332 was granted July 2, 1935.
Patent No. 2,600,374 was granted June 10, 1952.

them adequate protection for their developments, or whether they must choose other expedients for deriving income and benefit therefrom.

The present state of uncertainty as to the required standard of invention is detrimental to the public as well as to the patentees. There has been a noticeable trend indicating a decline in the number of applications for patents for inventions filed in the Patent Office during the last five years. Thus, in 1947—77,779 applications were filed; in 1948—73,256 applications were filed; in 1949—66,172 applications were filed; in 1950—69,117 applications were filed; and in 1951—63,077 applications were filed.* We do not know how much of this decline has been due to uncertainty on the part of inventors with regard to the validity of patents. We do not know how much of the decline has been due to the decision on the part of inventors to avoid this uncertainty and to treat their inventions as secret processes and techniques. If the decline is, even to a slight extent, attributable to these factors, then the public is being deprived of one of the prime benefits intended to be accomplished by our Patent Law, namely, the publication of new techniques, developments and processes which will advance the useful arts so that the public can practice the inventions upon the expiration of the patents.

It is accordingly submitted that it is important, both to the owners of the more than one-half million patents now in force and to the public in general, that the present state of uncertainty be corrected and that the questions presented by this petition be answered by the Supreme Court.

The Decisions Below Depart From the Traditional Standards of Invention

Over the years, certain objective tests have been recognized in determining whether a patent is valid:

* Figures taken from annual reports of Commissioner of Patents.

(1) *Invention resides in a new combination producing new and improved results.* It has long been recognized that a new combination of old elements may amount to invention and the fact that all of the elements in the combination are old is immaterial. *McCormic* v. *Talcott,* 20 How. U. S. 402, 404, 15 L. Ed. 930 (1858); *Webster Loom Company* v. *Higgins,* 105 U. S. 580, 586, 26 L. Ed. 1177 (1882); *Parks* v. *Booth,* 102 U. S. 96, 26 L. Ed. 54 (1880); *Williams Mfg. Co.* v. *United Shoe Machinery Co.,* 316 U. S. 364, 368-369, 86 L. Ed. 1537 (1942).

(2) *Invention is indicated where a patent makes a substantial contribution to the art.* The Supreme Court in the well-known case of *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 63, 67 L. Ed. 523 (1922) stated:

> "In administering the patent law the court first looks into the art to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent, to secure to the inventor the reward he deserves".

(3) *The normal presumption of validity is reinforced by the administrative determination of the Patent Office.* The normal presumption of validity attaching to a patent is greatly strengthened where the art relied upon was considered prior to granting the patent and to this presumption of validity there must now be added the "growing recognition of finality which is generally being accorded to administrative determinations". *Williams Mfg. Co.* v. *United Shoe Mach. Corporation,* 121 F. 2d 273, 277 (CCA 6th) aff'd 316 U. S. 364, 86 L. Ed. 1537. The Supreme Court has pointed out that the presumption of validity has "greatly increased weight" where, as in the present case, the application for the patent in suit was involved in

bitterly contested interference proceedings. *Hildreth* v. *Mastoras*, 257 U. S. 27, 32; 66 L. Ed. 112.

(4) *Invention is evidenced by a long lapse of time between the date of the prior art patents and the date of the invention and issue.* It has been recognized for many years that a long lapse of time between the principal prior art patents and the date of the filing of a patent application is evidence of invention. *Barbed Wire* cases, 143 U. S. 275, 284, 36 L. Ed. 154 (1891).

(5) *Invention is proven by the commercial success.* Ever since the case of *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 495, 23 L. Ed. 953, it has been recognized that commercial success is evidence of invention.

(6) *Invention is evidenced by an infringer's imitation.* Imitation is indeed the sincerest form of flattery. Where an infringer gives lip service to the prior art patents and yet persists in imitating the invention of the patent in suit, the imitation has traditionally been regarded as an indication of invention. *Diamond Rubber Company of New York* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428, 55 L. Ed. 527, 534.

It is believed that the Carpenter claims will be found to meet all of the above tests.

The Judiciary Has Not and Cannot Change the Standard of Invention

Art. 1, Sec. 8, Clause 8, of the constitution provides:

> "The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

At the time of the adoption of the constitution, the word "inventors" had a definite meaning. Under the English Common Law all that was required of an inventor was that he introduce a new manufacture, art, or industry into the realm and it made no difference whether the idea was created in any particular manner or by any particular type of genius. As the law developed the idea was not considered new if it were obvious to the proverbial "man skilled in the art".*

Pursuant to the constitutional provisions, Congress passed the Patent Act of 1790 entitled "An Act to promote the progress of useful Arts"; the Patent Act of 1793 entitled "An Act to promote the progress of useful Art; and to repeal the act heretofore made for that purpose"; the Patent Act of 1836 entitled "An Act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose"; and the Consolidated Patent Act of 1870 (16 Statutes at Large, 198). The patent laws were codified in 1874 but remained essentially the same as enacted in 1870. Since that time repeated attempts have been made to modify, weaken or emasculate the patent laws. Congress has repeatedly rejected these attempts and the patent laws remain essentially the same as they were in 1870.

The pertinent portion of the Patent Act of 1870 for our present purposes reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, * * * may, upon payment of the fees

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* Case of Monopolies (*Darcy* v. *Allein*) 1 I.W.P.C.; Noy 173; Moore, K.B., 671; 11 Co. Rep. 85. *Clothworkers of Ipswich* case, Godbolt 252, 1 Abb. Pat. Cases 6.

Statute of Monopolies, *Edgebury* v. *Stephens*, 1 I.W.P.C. 35; 2 Salk. 447, *Plimpton* v. *Malcolmson*, 3 Ch. D. 531.

required by law, and other due proceedings had, obtain a patent therefore'' (Revised Statute Sec. 4886; 35 U.S.C. Sec. 31).

All that the Statute requires is that the person ''invent'' a ''new'' and ''useful'' art, machine, manufacture, composition of matter or improvement thereof. We have already seen the meaning of ''inventor'' under the English Common Law. Congress has not modified the definition to require the inventor to reveal any higher standard of invention or any particular variety of genius. The Courts should not do so. It is believed, however, that the lower Federal Courts in recent years have inadvertently changed the law through misunderstanding of the opinions of this Court in cases which factually involve no departure from the established and traditional rules of law as to patentability and invention.

Under the circumstances, the traditional standard of invention, as recognized by this Court in the following cases must still prevail—*Barbed Wire* cases, 143 U. S. 275, 36 L. Ed. 154; *Diamond Rubber Company of New York* v. *Consolidated Rubber Tire Company, et al.*, 220 U. S. 428, 55 L. Ed. 527; *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 67 L. Ed. 523. This traditional standard of invention was apparently recognized by the Supreme Court as recently as *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 88 L. Ed. 721.

CONCLUSION

For the foregoing reasons this petition for a writ of certiorari should be granted.

Respectfully submitted,

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Dated: June , 1952

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 144

CARPENTER CONTAINER CORPORATION,
Petitioner,

v.

THE CONTAINER COMPANY,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

Opinions Below.

The opinion of the District Court (P.D.A.-136a)* is reported at 99 F. Supp. 167. The opinion of the Circuit Court of Appeals for the Third Circuit (C.R.P.C.A.-127) affirming the District Court is reported at 194 F. (2d) 1013.

* Abbreviations used:
P.D.A.—designates Petitioner Defendant's Appendix.
R.D.A.—designates Respondent Plaintiff's Appendix.
C.R.P.C.A.—designates Certified Record of Proceedings in Court of Appeals.

We do not agree with Petitioner's interpretation of the opinions below. First, Petitioner contends that the "specific claimed combination of the Carpenter patent was new". Judge Rodney's opinion, which was affirmed by the Court of Appeals, states that

> "An examination of the prior art patents shows clearly that the combination of these elements, considered in their broadest terms, did not constitute a new or novel combination at the time of the Carpenter application." (P.D.A.-142a)

and that "the exact combination of the elements *in all the details claimed*"* was not in any single prior art patent (P.D.A.-143a). The italicized portion of the above quotation is important because the opinions below found that the claims in suit were for a three-element combination of a body, a cover, and a split ring and that this combination was disclosed in several prior art patents. The claims differed from the prior art only in the specific "details claimed" but not as combinations. The lower courts found that these details were not sufficient to lend patentability in view of the prior art.

Secondly, the opinions below found that the claims did not "constitute patentable invention over the prior art". While the courts below, as stated in the petition, made reference to "the strict standards laid down by the Supreme Court" in previous cases, such as *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, and *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, there is nothing in the opinions below to indicate that the courts would have arrived at a different conclusion under what Petitioner calls the traditional standard of invention, whatever that may be.

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* All emphasis ours unless otherwise stated.

Therefore we disagree with Petitioner's statement (p. 3) that the opinions of the courts below are concerned with the present standard of invention required to sustain the validity of a patent. It is believed to be clear from the opinions below that the claims in suit are invalid under any standard of invention. Further reasons for this statement are given in our discussion (*infra*, p. 5) under the topic "The Decisions Below Depart From the Traditional Standards of Invention".

Jurisdiction.

The jurisdictional requisites are adequately set forth in the petition.

Questions Presented.

We submit that the only question presented by this case is whether or not the claims in suit are patentable in view of the prior art. We are unable to agree with Petitioner's statement of the questions presented.

Statutes Involved.

We have no comment on this portion of the petition.

Statement of the Case.

This is an action involving the validity of the Carpenter patent No. 2,382,858 for Container. The patent was held invalid "as not disclosing any patentable invention over the disclosure of the prior art" (P.D.A.-144a). The lower courts also held that the patent was for an old combination and that "improvement in one or more of the old elements, such as the clamping ring, does not make the old combination repatentable as such" (P.D.A.-144a).

The Findings of Fact (P.D.A.-146a to 148a) on which these holdings are based, are adequately supported by the evidence and Petitioner has not shown any of the Findings to be erroneous. Petitioner's Statement of the Case is inaccurate for the reasons set forth in our discussion of the Opinions Below (*supra*, p. 2).

No conflict with any other decision is involved either as to the patent in suit or as to a question of law.

Argument.

No sound reason for granting this petition has been advanced by Petitioner. We will discuss the points raised by Petitioner under the headings used in the petition.

"Reasons for Granting the Writ and Argument."

Under this heading Petitioner's argument is directed to two questions: First, that the questions raised in this petition have not been decided by the Supreme Court and, second, the questions are of great public importance. Neither of these statements is correct.

"The Questions Raised in This Petition Have Not Been Decided by the Supreme Court."

We have difficulty in comprehending Petitioner's argument on this point. Apparently Petitioner is under the impression that somewhere in the Constitution, or the patent statutes, or in decisions by this Court, there is some kind of a fixed standard of invention which Petitioner refers to as "the traditional standard of invention" or as "the standard established by the U. S. Constitution as traditionally interpreted and understood".

We know of no traditional standard of invention as stated in the Constitution, the patent statutes, or in any

decision by the Supreme Court of the United States. What constitutes invention in any given case has always been a matter of opinion of the Court to which the question was presented. Invention is impossible of fixed definition and can be determined in any given case by consideration of a multitude of factors peculiar to the particular case. In view of this, there is no such thing as a "Constitutional standard" (Petition, p. 3), nor is there any such thing as "the standard established by the U. S. Constitution as traditionally interpreted and understood" (Petition, p. 3).

Under this heading Petitioner also refers to decisions of certain lower courts indicating that such courts believe that the United States Supreme Court as presently constituted has laid down a higher or stricter standard of invention than that required heretofore and then proceeds to challenge the power of the Court "to thus modify *the Patent Laws* by requiring a stricter standard of invention" (Petition, p. 11).

We are unable to understand the relevancy of Petitioner's argument as to the belief by the lower courts that a higher standard of invention has been established by this Court. This question might be relevant in the present case if it appeared that the courts below would have held the claims in suit to be patentable under the mythical, "traditional standard of invention", but that these claims would be unpatentable solely because of some higher standard said to be required by this Court. Even then there would be no occasion for a writ of certiorari because if this Court has set a higher standard of invention it is the duty of the lower courts to accept the decisions of this Court as they understand such decisions as was well stated by Judge Learned Hand of the Second Circuit Court of Appeals in *Picard* v. *United Aircraft Corporation,* 128 F. 2d 632, 636, quoted by Petitioner (p. 8).

The petition (p. 11) requests a clarification by this Court of its views on the standard of invention, that is

to say, whether or not the standard has been raised, and a decision by the Court as to whether the judiciary has the power to *modify the patent laws* by requiring a stricter standard of invention. We submit that there is no occasion for a decision by the Court on either of these points and that these questions are not really presented in the present case.

"The Questions Presented by this Petition Are of Great Public Importance"

Petitioner's argument under this heading boils down to the proposition that each patent owner would like to know whether or not his patent is valid. This has been the situation ever since the first patent was granted and will continue until the last patent expires. Whether the Carpenter patent in this suit is valid is of no importance to other patent owners. Therefore, a decision by this Court on that patent would not be an answer to the question as to whether or not all other patents are valid. Petitioner is asking for the impossible and the argument under this heading does not, in our opinion, merit serious consideration.

"The Decisions Below Depart from the Traditional Standards of Invention"

Under this heading Petitioner sets up six items, the existence of which is supposed to indicate the presence of invention.

The first (p. 13) is *"Invention resides in a new combination producing new and improved results"*. This item does not apply to the claims of the patent in suit because these claims are not for a new combination. Judge Rodney in his Finding of Fact 6 (P.D.A.-147a), speaking of the claims in suit, states:

> "Each of these claims calls for the three element combination of a body, a head and a split clamping ring.

> • • • Each of the claims in suit is for a complete container structure employing the said three elements."

In Finding 7 (P.D.A.-147a) he states:

> "Many of the prior art patents in evidence disclose the same three element combination of a body, head and split clamping ring as that of the claims in suit".

He then lists eight U. S. patents disclosing this exact combination. These Findings of the trial court clearly show that the patent in suit does not respond to Petitioner's item 1 of the "Traditional Standards of Invention".

The second item (p. 13) is *"Invention is indicated where a patent makes a substantial contribution to the art"*. There is no evidence that the features of the claims in suit made any substantial contribution to the art. As a matter of fact, Judge Rodney in Finding 9 (P.D.A.-148) stated:

> "Insofar as the features of the claims in suit are concerned, the Grinden structure is the same as that of the Carpenter patent in suit".

Grinden was a patent long prior to Carpenter, thus showing that there was nothing in the claims in suit which made any substantial contribution over and above that which was prior to Carpenter.

The third item is *"The normal presumption of validity is reinforced by the administrative determination of the Patent Office."* There is nothing in this case to indicate that the normal presumption of validity was reinforced by anything which happened in the Patent Office sufficiently to overcome the disclosures of the prior art patents.

The fourth item (p. 14) is *"Invention is evidenced by a long lapse of time between the date of the prior art patents and the date of the invention and* (in) *issue."* This is an incomplete statement. We know of no decision which sup-

ports this item as so broadly stated by Petitioner. The long lapse of time in order to have any significance must be accompanied by the solution of a problem that existed throughout this long period of time and must be accompanied by the further fact that when the problem was solved the art abandoned the old and went to the new. There is not a word of evidence in this case that any of these things was in the present case. As a matter of fact, as we have shown above in connection with Petitioner's item 2, the Grinden patent which issued in April 1918, some twenty-seven years prior to the issuance of the Carpenter patent, "is the same as that of the Carpenter patent in suit" (Finding 9, P.D.A.-148a) insofar as the features of the claims are concerned. In view of this Finding, we are unable to see how the lapse of time can be of any comfort or assistance to Petitioner.

The fifth item (p. 14) is *"Invention is proven by the commercial success."* Obviously, this statement is incorrect. We know of no decision by the Supreme Court which says that commercial success alone proves invention. It is the established law of the land that commercial success can be considered only when invention is in doubt and that under certain circumstances it might turn the scale in favor of invention. In the present case, commercial success was not proved. There is not a word of evidence in the case to show that the structure of the claims enjoyed any commercial success and of course there was nothing to show that any feature of any claim in suit made any contribution to any commercial success of the claimed structure.

The sixth item (p. 14) is *"Invention is evidenced by an infringer's imitation."* There is no evidence in this case and no finding by the trial court that the accused structures were imitations of the claimed structures. In fact this would be impossible in view of Judge Rodney's Finding 7 (P.D.A.-147a) that insofar as the features of the

claims in suit are concerned, "the Grinden structure is the same as that of the Carpenter patent in suit".

From the foregoing it is evident that based upon the Findings of Fact of the trial court, affirmed by the Court of Appeals, the claims in suit in the present case do not meet a single requirement which Respondent has set up as necessary to the traditional standard of invention. Under these circumstances, so far as the present case is concerned, it is apparent that it makes no difference whatever whether or not this Court has set up a higher or stricter standard of invention than that which Petitioner chooses to call the traditional standard of invention. The claims in suit are invalid as measured by any standard which has ever been set up by this Court.

"The Judiciary Has Not and Cannot Change the Standard of Invention"

We are unable to understand Petitioner's argument under this heading for the very simple reason which we have already stated, namely, that what constitutes invention in any given case is a matter of opinion of the Court before whom the question is presented. Furthermore, there never has been and probably never will be any fixed standard or yardstick by which the presence or absence of invention can be determined in all cases. Whether or not invention exists in a given case depends upon numerous factors, which factors are never the same in any two cases. Petitioner's argument seems to be that the present Court would be changing the patent statutes or the Constitution of the United States if it expressed an opinion as to the presence or absence of invention which differed from the mythical and non-existent "traditional standard of invention".

Obviously Petitioner does not think that this Court has changed the standard of invention from that of long ago

because it states (p. 16) that "This traditional standard of invention was apparently recognized by the Supreme Court as recently as *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 88 L. Ed. 271." In that case, the patent in suit was held valid and infringed, but in the *Great Atlantic & Pacific Tea Company* v. *Supermarket Corporation* (*supra*), this Court held the patent there in suit invalid. Since the *A. & P.* case is subsequent to *Ray-O-Vac* case, we presume that Petitioner feels that this Court departed from the "traditional standard" in the *A. & P.* case.

Judge Rodney in his opinion (P.D.A.-141a), stated:

> "To the extent that the combinations claimed in these claims may be merely combinations of old elements, it is clear that to be patentable, they must demonstrate something new and useful, either in the result or the method of its achievement. Marconi Wireless Co. v. United States, 320 U. S. 1, A. & P. Tea Co. v. Supermarket, 340 U. S. 147."

He then went on to find that the combinations claimed were the same as disclosed in the Grinden patent, as we have previously shown by the quotation from his Findings 6 and 7. This is the standard which has always been used for combination claims. Evidently Petitioner feels that the standard of invention was raised by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, was lowered in *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, and was raised again in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.*, 340 U. S. 147. We believe that the action of this Court in the *Cuno* case where the patent was held invalid for lack of invention, in the *Ray-O-Vac* case where the patent was held valid and infringed, and in the *A. & P.* case where the patent was held invalid for lack of invention, shows that this Court has followed the same pattern as the Su-

preme Court of the United States has followed throughout its history, namely, that whether or not invention is present in a given case depends upon the particular facts of that case and that it is not determined by some fixed standard or yardstick, traditional or otherwise. The present case presents no problems that would be of general interest and therefore there is no occasion for the granting of the petition since the trial court came to the conclusion that the claims in suit were invalid in view of the prior art and was affirmed in this Finding by the Third Circuit Court of Appeals.

CONCLUSION.

For the foregoing reasons it is submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

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Dated: July 23, 1952.